

Notice of Allowability

Application No.

09/893,878

Examiner

Jeff Lundgren

Applicant(s)

LADNER ET AL.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/26/06.
2. ☒ The allowed claim(s) is/are 1-4,8,10-16 and 19.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Status of the Claims

Claims 1-17 and 19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in the Office Action mailed on August 11, 2006. The Examiner's Amendment to the claims presented below overcomes each of the outstanding rejections, and places the claims in condition for allowance.

Amendments to the Claims

Authorization for this Examiner's Amendment was given in a telephone interview with Ms. MaryDilys Anderson on August 8, 2006.

The application has been amended as follows:

In claim 1, line 2 of step (d), after the phrase "from cells that do not so bind," insert the phrase "wherein a potential binding domain that binds the target material is a successful binding domain (SBD),".

In claim 1, line 2 of step (e), after the word "comprising" insert the phrase "an SBD".

In claim 1, line 2 of step (e), delete the phrase "a successful binding domain (SBD) which bound said target".

In claim 2, line 1, after the phrase "one or more of said", insert the word "potential".

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In claim 2, toward the end of line 2 and carrying over to line 3, delete the phrase “a naturally occurring” and insert the term “an” in place thereof.

In claim 3, line 1, after the term “said” insert the term “potential”.

In claim 3, toward the end of line 2 and carrying over to line 3, delete the phrase “a naturally occurring” and insert the term “an” in place thereof.

In claim 4, line 1, after the term “said” insert the term “potential”.

Claims 5-7 are canceled.

In claim 8, line 1, after the term “said” insert the term “potential”.

In claim 8, line 1, after the term “binding” insert the term “protein”.

In claim 8, line 1, before the term “comprises” delete the term “antibody”.

In claim 8, line 2, after the term “naturally occurring” delete the “protein” and insert the term “antibody” in place thereof.

Claim 9 is canceled.

In claim 10, line 2, delete the phrase “a naturally occurring” and insert the term “an” in place thereof.

In claim 11, line 2, delete the phrase “a naturally occurring” and insert the term “an” in place thereof.

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In claim 12, line 2, delete the phrase “a naturally occurring” and insert the term “an” in place thereof.

In claim 13, line 2, delete the phrase “a naturally, occurring” and insert the term “an” in place thereof.

In claim 16, line 2, after the phrase “plurality of different” insert the phrase “potential binding”.

Cancel claim 17.

Reasons for Allowance

The following is an examiner's statement of reasons for allowance: Applicants claimed invention is the first to provide a population of eukaryotic cells with a nucleic that encodes a potential binding domain, in that the potential binding domain is derived from a gene obtained by random mutagenesis of a limited number of predetermined codons, and is fused to a genetic element which causes the resulting chimeric expression product to be displayed on the outer surface of the eukaryotic cell. The closest prior art, Reske (Reske *et al.*, *Eur. J. Immunol.* 17:909-914 (1987)), neither explicitly discloses or fairly suggest in combination with any other reference Applicants' claimed invention. Although Reske provides cells displaying certain antigens, Reske does not meet the limitations of Applicants' population of variegated cells, nor the potential binding domain.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Conclusions

Claims 1-4, 8, 10-16 and 19 are allowed.

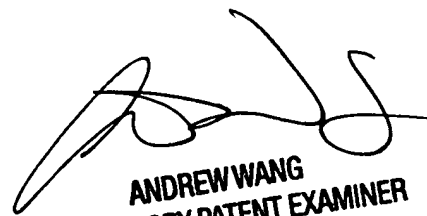
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Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Peter Paras, can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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